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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,308	09/08/2003	Renato Belz	21933-US	9743

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ROCHE MOLECULAR SYSTEMS INC
PATENT LAW DEPARTMENT
1145 ATLANTIC AVENUE
ALAMEDA, CA 94501

EXAMINER

REDDING, DAVID A

ART UNIT	PAPER NUMBER
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1744

MAIL DATE	DELIVERY MODE
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06/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/657,308

Applicant(s)

BELZ ET AL.

Examiner

David A. Redding

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 3/1/07 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,720,406 (Fassbind et al.) in view of USP 6,776,964 ('964) and USP 4,226,333 (Percarpio).

The "406 patent discloses a plurality of reaction containers (91) with corresponding plurality of closures (95) which is placed into a device for performing thermal cycling (see description of figure 1 and col.1, lines 20-23). Figure 1 shows a ring of reaction containers (91) and a ring of closures (95), each of which are two-dimensional (X and Y axis). The reaction vessels are connected to one another via a flexible connector (94) and the closures connected to an adjacent closure via a flexible connector (96) (col.3, lines 59-61; col.4, lines 1-5). The patent also discloses that the device is equipped with a handle (99,102) which has a surface upon which a bar code label can be placed (col.4, lines 10-11). Further, the apex of the connector (96) is considered to read on the limitations of claim 3.

In Fassbind et al. the closures have rounded tops, not recesses. The '964 patent shows a closure assembly comprising caps which do have cylindrical recesses (figure 4). Accordingly, it would have been obvious to one skilled in the art to provide the closures in Fassbind et al. with recesses as shown in the '964 patent as a matter of choice of design.

The Fassbind et al. and '964 patents are silent as to providing a tool with having a handle with pin for insertion into the recess of the cap for seating the cap. Figures 2 and 3 in the Percarpio patent shows the use of a tool (34) as claimed for the same function as claimed (see col. 4, lines 40-56). Accordingly, it would have been obvious to one skilled in the art to provide the tool (34) in Percarpio with the closure in the '964 patent with the containers in Fassbind et al. in view of the tools known use.

Response to Arguments

The arguments are addressed in the order in which they appear in applicant's response filed 3/1/07.

1. "...Applicants have amended claim 6 to make the distinction that the vessel system defined by claim 6 comprises a matrix array of vessels and a matrix array of corresponding closure elements, wherein each vessel is connected to at least one other vessel via a flexible connecting member, and wherein each closure element is connected to at least one other closure element via a flexible connecting member that allows a change in the distance between the closure elements. This underlined feature is important because it provides the necessary flexibility which makes it possible to close all vessels of the array of vessels with corresponding closure elements in spite of manufacturing tolerances which cause variations of the positions of the vessels. None of the references cited by the Examiner anticipate or suggest such a vessel system."

The examiner disagrees with this argument. Figure 1 in Fassbind shows that the matrix of vessels are connected to one another via a flexible element 94 and that the matrix of closures are connected by flexible element 96.

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Each of these elements are constructed to allow the distances between the vessels and closures to change (col.3, lines 59-61; col.4, lines 1-5).

2. "The Fassbind publication discloses the use of rounded tops designed to close the container in a gas-tight manner, but Fassbind does not disclose or suggest the use of closure elements having a cylindrical recess into which a pin can be pressed to close the openings of the vessels, as defined by claim 6. The Wijnschenk publication discloses a sealing mat closure assembly comprising cylindrical recesses, but these recesses are designed for functionalities different from those defined in the present invention. For example, Wijnschenk discloses "...it is particularly advantageous if the sealing elements are constructed such that they can be punctured by a needle, preferably relatively easily" (Wijnschenk column 4 lines 28-30). The functionalities of the recesses as defined by claim 6 includes the accommodation of a pin to close the vessels and not to pierce the vessels. Wijnschenk's sealing mat closure device teaches away from the use of a pin to close the openings of the vessels in the present invention because the cylindrical recesses of Wijnschenk are designed to be punctured "easily", a feature not found in the present invention. "

In evaluating a prior art reference one must consider what the reference teaches as a whole and not limit the teaching to the preferred embodiments. While it is true that the Wijnschenk patent discloses that the sealing elements are constructed to be pierced by a needle, the patent also discloses that the sealing elements can be made from "a flexible **and/or resilient material** (see abstract). The primary function of the sealing elements is that they provide a leak proof seal with the vessel. Inherently, a resilient material designed primarily to provide a leak-proof seal would be one which could accommodate the pin in Percarpio for sealing.

3. "The examiner has not demonstrated any suggestion or motivation, other than "design choice", to combine the cylindrical recesses of Wijnschenk with the rounded top closures of Fassbind. In the present invention, the design of the recesses is not a cosmetic "design choice" as the Examiner asserts; the cylindrical recess design of the present invention serves a functional and important purpose - the accommodation of a pin for closure of the vessels. There is no suggestion or motivation provided in Fassbind for modifying the rounded tops to have a cylindrical recess as provided by Wijnschenk nor is there suggestion or motivation provided by Wijnschenk for modifying the design of rounded tops such as in Fassbind to incorporate a cylindrical recess for any purpose. "

The motivation to combine the closures of Wijnschenk with the vessels in Fassbind comes from the disclosure that the closures in Wijnschenk are for sealing test tubes, similar to the test tubes in Fassbind.

4. "The Percarpio publication discloses the use of a tool for inserting and removing closure elements; the Fassbind and Wijnschenk publications do not disclose such a device. In fact, Wijnschenk teaches away from using a tool; in describing the prior art Wijnschenk discloses: "A further disadvantage {of the prior art} is that tools must be used if an individual (single) sealing element has to be fitted" (Wijnschenk col. 1 lines 31-32). Additionally in Wijnschenk, the closure assembly is removed by pulling away the carrier sheet to which the closure elements are attached (Wijnschenk abstract). No tools are required or even suggested in Wijnschenk in order to use the closure assembly as disclosed. The Examiner has not provided any suggestion or motivation in Wijnschenk to incorporate the use of a tool such as described by Percarpio. Further, the tool of Percarpio would not function in combination with the rounded caps of Fassbind. Therefore there is no reasonable expectation of success for combining the tool of Percarpio with the closures in Fassbind. And the Examiner has not provided motivation or suggestion to Fassbind to incorporate the use of a tool such as described by Percarpio. "

The examiner disagrees that Wijnschenk teaches away from using a tool disclosed in Percarpio. The citations given by applicant refer to removing the sealing elements, not in seating the sealing elements to the tubes which the tool would be used for. The motivation for using such a tool in Wijnschenk is to ensure that the sealing elements are properly seated into the mouths of the test tubes.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action.

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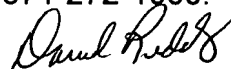
In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Redding whose telephone number is 571-272-1276. The examiner can normally be reached on Mon.-Fri. 6:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran-Piazza can be reached on 571-272-1224. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David A Redding
Primary Examiner
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DAR